

REMARKS

This response is submitted in response to the Office Action of August 14, 2000, wherein the Examiner has rejected claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over either Powers et al. in view of Leonard.

Applicant respectfully disagrees with the Examiner's statement that "Powers discloses the claimed invention, except for the use of a detectable insert for enabling recovery of the earplugs."

Powers discloses corded earplugs and a method of attaching the cord. Powers uses a piercing tool or "bodkin" thrust at a high velocity into the center of the larger end face of the plug remaining there for 3-4 seconds. Bodkin is removed and free end of cord is inserted into preformed hole. *Powers does not teach or suggest a detectable insert encapsulated within a foam body such that the foam body completely surrounds the detectable insert, as is required by the Claims.*

Leonard teaches taking a metal ball and inserting it into a specially formed channel with wall contouring that retains the metal ball in the stem of the earplug. *Leonard neither teaches nor suggests encapsulation of a detectable insert within a foam body such that the foam body completely surrounds the detectable insert, as is required by the Claims.*

The proposed combination of references is insufficient to make out a prima facie case of obviousness. MPEP, section 706.02(j) states:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference

or to combine reference teachings. Second, there must be a *reasonable expectation of success*. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. The teachings or suggestion to make the claimed combination and the reasonable expectation of success *must both be found in the prior art* and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

First, there is no suggestion or motivation to combine Powers and Leonard. Leonard actually teaches away from Powers by requiring that the earplug have a channel and by requiring that the detectible insert have a diameter large enough so that the insert will be restricted from coming out of the channel during normal use. Powers does not contemplate detectible inserts (or any other inserts). Because there is no motivation to combine Leonard and Powers, the rejection is improper. Applicants respectfully request that the rejection be withdrawn pursuant to reconsideration and that the claims be allowed to pass to issue.

Second, the proposed combination does not teach or suggest all of the claim limitations. Neither reference teaches a detectible insert encapsulated within the foam body, the foam body completely surrounding the detectible insert. A prima facie case of obviousness cannot be established because the prior art fails to teach or suggest this limitation. Accordingly, reconsideration and allowance of the Claims is respectfully requested.

With regard to various dependent claims, Applicant's dependent claim 13 recites inserting a punch into the foam body and its dependent claim 15 recites chilling the punch. Powers neither discloses use of a channel-forming punch nor chilling of its piercing tool.

Applicant has shown that chilling reduces dwell time and increases manufacturing efficiency, clear improvements over the existing art which are not obvious from the Powers and Leonard references. For these additional reasons, Applicants respectfully request reconsideration and allowance of claims 13 and 15.

Further to the above discussion with regard to independent claims 1 and 7, Applicant's claim 16 also teaches projecting the insert into the foam body at a predetermined projectory and speed. The detectable insert is projected into the foam body and the foam body is allowed to encapsulate the insert so that the detectable insert is completely surrounded by the foam body. The references are silent (no teaching or suggestion) on *projecting a detectable insert into a foam body* and allowing the foam body to encapsulate the detectable insert so that the insert is completely surrounded by the foam body. For these additional reasons, Claim 16 and claims 17-21, dependent thereon, should be allowable. Reconsideration and allowance is respectfully requested.

Accordingly, as the references cited in the Office Action do not render obvious that which the Applicant deems to be the invention, it is respectfully requested that claims 1-23 be passed to issue. The remaining references, although not cited as prior art, were found to be even less relevant and therefore no further discussion is required.

It is believed that the foregoing remarks fully comply with the Office Action.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicant's Attorneys.

Respectfully submitted,
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